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10/813,723	03/31/2004	Robert P. Morris	1222/US	7416

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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/813,723	MORRIS, ROBERT P.
	Examiner	Art Unit	
	SELAM T. GEBRIEL	2622	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>31 March 2004</u>.

2a) ☐ This action is FINAL.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>43-78</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>43-78</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>31 March 2004</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2.   Claims 61 – 78 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 61 – 78 disclose "a computer-readable medium containing executable instructions for specifying and automating file handling in a portable image capture device". As disclosed in the claims, "In the context of this claims", "In particular, the executable instructions for specifying and automating file handling in a portable image capture device can be recorded or downloaded in advance on a hard disk or a semiconductor memory as a computer-readable medium built in the portable image capture device. Alternatively, the executable instructions may be temporarily or permanently stored (recorded) on such computer-readable medium as a floppy disk, a CD-ROM (Compact Disc Read Only Memory), an MO (Magneto-optical) disk, a DVD (Digital Versatile Disc), a magnetic disk or a semiconductor memory then later downloaded into the portable device .It can also be noted that the executable instructions may be installed into the portable image capture device from such a computer-readable medium as described above, or alternatively may be transferred by radio to the portable image capture device from a download site through an artificial satellite for digital satellite broadcasting, or may be transferred by wire to the portable image capture device over a network such as a LAN (Local Area Network) or the

Internet". As disclosed in the claims, the "computer-readable medium" is defined as a

signal (may be transferred by radio to the portable image capture device from a down

load site through an artificial satellite for digital satellite broadcasting, or may be

transferred by wire to the portable image capture device over a network such as a LAN

(Local Area Network) or the Internet or installed into a built-in hard disk of the portable

image capture device). A signal is not tangibly embodied.

Also, claims 61 – 78 recite " a computer-readable medium containing executable

instructions for specifying and automating file handling in a portable image capture

device:" A executable instructions as claimed is not tangible since it does not establish a

connection between a computer-readable medium and said portable image capture

device. Since executable instructions are merely a set of instructions capable of being

executed by a computer or the portable image capture device, the executable

instructions logic itself is not a process; therefore the invention as claimed is non-

statutory. It is suggested that the preamble is changed to read "A computer-readable

medium _encoded with computer_ executable instructions for specifying and

automating…"

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

4.   Claims 61 – 78 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. Applicant claimed a "Computer – readable medium containing executable instructions for specifying and automating file handling in a portable capture device" the examiner could not determine from the disclosure as to whether the applicant had possession of what is being claimed and could not determine as to what the applicant regard as a "computer – readable medium". The specification Page 2, Section 0019 discloses "the present invention solves this problem by taking advantage of the user interface (UI) of the computer 20 and server and enabling the user to automate the file handling capabilities of the portable image capture device by configuring an action list 24 by mapping one or more user input events on the device to one or more image handling action". It is not clear as to whether the computer – readable medium is connected with either the camera or server or it is a software that resides in the camera or the server or a stand alone system or unit or a program. Examiner rejected claims 62 – 72 as best understood as to what the applicant regards as Computer -readable medium.

Clarification is required

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2)
of such treaty in the English language.

6.   Claims 43, 47 – 57 and 61 – 78 are rejected under 35 U.S.C. 102(e) as being

anticipated by Anderson (US 7117519 B1).

The applied reference has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art

under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome

either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in

the reference was derived from the inventor of this application and is thus not the

invention "by another," or by an appropriate showing under 37 CFR 1.131.

7.   Regarding Claim 43, Anderson discloses a method for specifying and automating

file handling in a portable image capture device (Figure 1, Element 14, Col 3, Line 43 -

52), the portable image capture device including at least one stored file (Figure 1,

Element 34) and configured to communicate with a computer (Figure 1, Element 24),

the method comprising:

In response to a user configuring an action list (Figure 5, Element 48) on the

computer (Figure 1, Element 24) by mapping one or more user input events (Col 8, Line

18 – 19, User initiating image upload, the user will upload the images once there is a

connection between the camera and server) on the portable image capture device to

one or more file handling actions (Col 8, Line 23 – 27, sending the images to a list of

email address, performing some type of analysis or calculation on the image data) on

the at least one stored file (The image saved inside the camera and then uploaded to

the server when there is connection between the camera and the server), downloading

the action list from the computer to the portable image capture device (Col 10, Line 58 –

63 and Col 8 and Col 9, Line 1 – 12, "The action list is displayed to the user on the

image capture device for user selection once a connection between the server and

camera is detected"); and

Performing the corresponding file handling action on the at least one stored file

within the portable image capture device when an input event on the portable image

capture device is detected that matches one of the user input events in the action list

(Col 8, Line 14 – 46).

8.   Regarding Claim 47, Anderson discloses the method of claim 43 wherein the at

least one stored file comprises a digital image (Figure 1, Element 34) by the portable

image capture device.

9.   Regarding Claim 48, Anderson discloses the method of claim 43 wherein the

computer is used to access a server via a web browser (Figure 1, Element 24, and Col

8, Line 65), the method further comprising: configuring the action list on the server in

response to user input (Col 8, Line 47 – 61 and Col 7, Line 16 - 22).

10.   Regarding Claim 49, Anderson discloses the method of claim 48 further

comprising retrieving the user's account information (Col 7, Line 64 – 67 to Col 8, Line 1

– 6), including the device type and an operating environment of the device in response
to the user logging into the server (Figure 1 Element 12).

11.   Regarding Claim 50, Anderson discloses the method of claim 49 further
comprising displaying to the user a list of supported user interface input events specific
to the user's type of device for the user to select a desired set of input events (Col 8,
Line 7 – 22, User Initiating an image upload is one input event that is specific to the
user's type of device).

12.   Regarding Claim 51, Anderson discloses the method of claim 50 further
comprising displaying a set of actions that can be performed when each selected event
occurs for the user to map one or more actions to each event (Figure 5, and Col 8, Line
23 - 46).

13.   Regarding Claim 52, Anderson discloses the method of claim 51 wherein the set
of actions may include any combination of e-mailing the file as an attachment, posting
the file to a photo sharing service, posting the file to a specified web site, resizing if the
file is an image, and saving the file to a folder (Figure 5, and Col 8, Line 23 - 46).

14.   Regarding Claim 53, Anderson discloses the method of 51 further comprising
storing the mappings as a downloadable action list (Col 8, Line 18 – 46).

15.   Regarding Claim 54, Anderson discloses the method of claim 43 further including requesting the action list from the computer by the device (Col 7, Line 64 – 67 to Col 8, Line 22, "Once there is a connection with the server and the camera, all the action list associated with that camera will be downloaded in the camera").

16.   Regarding Claim 55, Anderson discloses the method of claim 54 further comprising:

Transmitting identity information from the device to the server for the server to use to retrieve the action list configured by the user (Col 7, Line 64 – 67 to Col 8, Line 22); and

Downloading the action list to the device (Col 7, Line 64 – 67 to Col 8, Line 22, "Once there is a connection with the server and the camera, all the action list associated with that camera will be downloaded in the camera").

17.   Regarding Claim 61, Anderson discloses a computer-readable medium containing executable instructions for specifying and automating file handling in a portable image capture device, the device including at least one stored file and configured to communicate with a computer, the instructions, when executed:

Downloading an action list from the computer to the device, the action list comprising a mapping of one or more user input events on the portable image capture device to one or more file handling actions on the at least one stored file; and performing a corresponding file handling action on the file within the device when an input event on

the device is detected that matches one of the events in the downloaded action list (Col 5, Line 64 – 67 to Col 6, Line 1 – 49, "Camera 14 includes a microprocessor- based architecture that runs an operating system 70 for controlling camera hardware 72 and overall functionality of the camera 14 such as taking pictures, storing pictures, and the like").

18.   Regarding Claim 62, Anderson discloses the computer-readable medium of claim 61 further comprising providing an interface that allows a user to configure the action list (Col 5, Line 64 – 67 to Col 6, Line 1 – 49).

19.   Regarding Claim 63, Anderson discloses the computer-readable medium of claim 61 further including instructions for downloading an executable file associated with the file handling action to be performed and executing the executable file in the device in order to perform the action (Col 5, Line 64 – 67 to Col 6, Line 1 – 49).

20.   Regarding Claim 64, Anderson discloses the computer-readable medium of claim 63 further comprising instructions for downloading the executable file corresponding to the file handling action when the action is to be performed (Col 5, Line 64 – 67 to Col 6, Line 1 – 49).

21.   Regarding Claim 65, Anderson discloses the computer-readable medium of claim 63 further including instructions for downloading all the executable files associated with

the actions in the action list at the time the action list is downloaded (Col 5, Line 64 – 67

to Col 6, Line 1 – 49).

22.   Regarding Claim 66, Anderson discloses the computer-readable medium of claim

61 wherein the at least one stored file comprises a digital image captured by the

portable image capture device (Col 5, Line 64 – 67 to Col 6, Line 1 – 49).

23.   Regarding Claim 67, Anderson discloses the computer-readable medium of claim

61 wherein the computer is used to access a server via a web browser, the computer-

readable medium having further instructions for configuring the action list on the server

in response to user input (Col 5, Line 64 – 67 to Col 6, Line 1 – 49).

24.   Regarding Claim 68, Anderson discloses the computer-readable medium of claim

67 further comprising instructions for retrieving the user's account information, including

the device type and an operating environment of the device in response to the user

logging into the server (Col 5, Line 64 – 67 to Col 6, Line 1 – 49).

25.   Regarding Claim 69, Anderson discloses the computer-readable medium of claim

67 having further instructions for displaying to the user a list of supported user interface

input events specific to the user's type of device for the user to select a desired set of

input events (Col 5, Line 64 – 67 to Col 6, Line 1 – 49).

26.   Regarding 70, Anderson discloses the computer-readable medium of claim 69
having further instructions for: displaying a set of available actions that can be
performed when each selected event occurs; and providing an interface for the user to
map one or more actions to each event (Col 5, Line 64 – 67 to Col 6, Line 1 – 49).

27.   Regarding Claim 71, Anderson discloses the computer-readable medium of claim
70 wherein the set of available actions may include any combination of e-mailing the file
as an attachment, posting the file to a photo sharing service, posting the file to a
specified web site, resizing if the file is an image, and saving the file to a folder (Col 5,
Line 64 – 67 to Col 6, Line 1 – 49).

28.   Regarding Claim 72, Anderson discloses the computer-readable medium of claim
70 having further instructions for storing the mappings as a downloadable action list
(Col 5, Line 64 – 67 to Col 6, Line 1 – 49).

29.   Regarding Claim 73, Anderson discloses the computer-readable medium of claim
67 having further instructions for requesting the action list from the computer (Col 5,
Line 64 – 67 to Col 6, Line 1 – 49).

30.   Regarding Claim 74, Anderson discloses the computer-readable medium of claim
73 having further instructions for transmitting identity information from the device to the

server for the server to use to retrieve the action list configured by the user and downloading the action list to the device (Col 5, Line 64 – 67 to Col 6, Line 1 – 49).

31.   Regarding Claim 75, Anderson discloses the computer-readable medium of claim 67 having further instructions for downloading an executable file that is compatible with the device's operating environment (Col 5, Line 64 – 67 to Col 6, Line 1 – 49).

32.   Regarding Claim 76, Anderson discloses the computer-readable medium of claim 61 having further instructions for: detecting the input events on the device; comparing the detected input events to the events listed in the downloaded action list; and if a match occurs, performing the corresponding action or actions in the list by retrieving the executable file necessary to execute that action (Col 5, Line 64 – 67 to Col 6, Line 1 – 49).

33.   Regarding Claim 77, Anderson discloses the computer-readable medium of claim 76 having further instructions for: determining if the executable file is present in memory of the portable image capture device; and if the executable file is present in the memory, retrieving and executing the executable file, thereby performing the action (Col 5, Line 64 – 67 to Col 6, Line 1 – 49).

34.   Regarding Claim 78, Anderson discloses the computer-readable medium of claim 77 having further instructions for: if the executable is not present in the memory:

requesting the executable file from the computer; and executing the executable file once

received (Col 5, Line 64 – 67 to Col 6, Line 1 – 49).

Claim Rejections - 35 USC § 103

35.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

36.   Claims 44, 45, 46 and 56-60 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Anderson (US 7117519 B1) in view of Shiohara et al. (US

7,283,158).

37.   Regarding Claim 44, Anderson failed to teach downloading an executable file

associated with the corresponding file handling action to the portable image capture

device; and executing the executable file in the device in order to perform the file

handling action.

   Shiohara discloses downloading an executable file (Programs for generating print

image data) associated with the corresponding file handling action (Print image data) to

the portable image capture device; and executing the executable file in the device in

order to perform the file handling action (Abstract, Figure 5, and Col 2, Line 60 – 67 to

Col 3, Line 1 – 35) .

Therefore it would have been obvious to one ordinary skilled in the art at the time the invention was made to modify the teaching of Anderson with Shiohara method of downloading an executable file or program associated with a corresponding file handling action. The motivation to do so is to effectively utilize the limited memory capacity of the digital camera, it is important that programs for generating print image data each having a relatively large program size can be installed from the external device into the digital camera as occasion demands or such installed programs can also be deleted. If the program is handled in such way, different programs, for example, a direct printing program, a communication program, an image correction program, or the like, can be replaced and then employed (Col 3 Line 10 – 19).

38.   Regarding Claim 45, Anderson in view of Shiohara disclose the method of claim 44 wherein downloading the executable file associated with the file handling action to be performed comprises downloading the executable file corresponding to the file handling action when the action is to be performed (Col 2, Line 60 – 67 to Col 3, Line 1 – 35).

39.   Regarding Claim 46, Anderson in view of Shiohara disclose the method of claim 44 further comprising downloading all executable files associated with the file handling actions in the action list at the time the action list is downloaded (Col 2, Line 60 – 67 to Col 3, Line 1 – 35, "Reading out the program from the recording medium in the digital medium at a desired time").

40.   Regarding Claim 56, Anderson in view of Shiohara disclose the method of claim
55 wherein performing the corresponding file handling action (Print image data) includes
downloading an executable file that is compatible with the device's operating
environment (Shiohara, Col 2, Line 60 – 67 to Col 3, Line 1 – 35).

41.   Regarding Claim 57, Anderson in view of Shiohara disclose the method of claim
56 wherein the device sends operating environment information to the server in the
request in order for the server to find the action executable file appropriate for the
device's operating environment (Shiohara, Col 2, Line 60 – 67 to Col 3, Line 1 – 35).

42.   Regarding Claim 58, Anderson in view of Shiohara disclose the method of claim
43 further comprising retrieving an executable file necessary to perform the
corresponding file handling action (Shiohara, Col 2, Line 60 – 67 to Col 3, Line 1 – 35).

43.   Regarding Claim 59, Anderson in view of Shiohara disclose the method of claim
58 further comprising:

        Determining if the executable file is present in memory of the portable image
capture device (Shiohara, Col 2, Line 60 – 67 to Col 3, Line 1 – 35); and

        If the executable file is present in the memory, retrieving and executing the
executable file from the memory, thereby performing the action (Shiohara, Col 2, Line
60 – 67 to Col 3, Line 1 – 35).

44.   Regarding Claim 60, Anderson in view of Shiohara disclose the method of claim

59 further comprising:

        If the executable is not present in the memory of the portable image capture

device: retrieving the executable file from the computer; and executing the executable

file (Shiohara, Col 2, Line 60 – 67 to Col 3, Line 1 – 35).

Conclusion

        Any inquiry concerning this communication or earlier communications from the

examiner should be directed to SELAM T. GEBRIEL whose telephone number is

(571)270-1652. The examiner can normally be reached on Monday-Thursday 7.30am-

5.00pm.If attempts to reach the examiner by telephone are unsuccessful, the

examiner's supervisor, Vu NgocYen can be reached on 571-272-7320. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300. Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S.G.
Thursday, March 27, 2008   */Ngoc-Yen T. VU/*
                                    Supervisory Patent Examiner, Art Unit 2622